

PATENT APPLN. NO. 10/532,481
RESPONSE UNDER 37 C.F.R. §1.111

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REMARKS

Initially, it is noted that claim 1 has been amended to limit the method of the invention to one for producing a three-layer fiber product as previously recited in claim 8 and to limit the method for forming the three-layer product to a multilayer forming process as originally recited in claim 2. Claim 2 has been canceled and claim 8 has been amended for consistency with the amendment to claim 1.

Claim Objections

Claim 4 has been amended to recite a dependency on claim 1 and claim 12 has been canceled.

Removal of the objections to the claims is respectfully requested.

Claim Rejections - 35 USC § 112

The dependent claims of the application have been amended to provide proper antecedent basis for the claim terminology.

The amendments are believed to overcome the reasons for the 35 U.S.C. § 112, second paragraph, rejection of the claims and removal of the rejection is respectfully requested.

Claim Rejections - 35 USC § 102/35 USC § 103(a)

Claims 1, 3-12, 14 and 15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Silenius et al., U.S. Patent Application Publication No. 2004/0168779 ("Silenius").

It is noted first that this rejection is not proper. U.S. Patent Application Publication No. 2004/0168779 is not an effective reference against the claims of the present application under 35 U.S.C. § 102(e). The effective date of the publication as a reference under 35 U.S.C. § 102(e) is April 22, 2004, which is subsequent to the international filing date of the present application, October 24, 2003.

Notwithstanding that U.S. Patent Application Publication No. 2004/0168779 is not a proper reference against the claims, claim 1 has been amended to include the limitations of claim 2, which is not included in the 35 U.S.C. § 102(e) rejection. The rejection is now moot.

Claims 2 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Silenius in view of Begemann et al., EP 0824157 ("Begemann").

This rejection is also improper in view of the fact that Silenius is not a proper reference against the claims of the present application.

Claims 1, 4-12 and 16-19 [sic] are rejected under 35 U.S.C. § 103(a) as being unpatentable over Begemann in view of Silenius, U.S. Patent Application Publication No. 2001/0000063 ("Silenius '063") as evidenced by Peel et al., Paper Science and Paper Manufacture.

Initially, applicants note that it appears that the Office intended to apply this rejection against claims 1-15 of the application. The rejection is applied to claims 1-15 on pages 8-10 of the Action.

Begemann discloses a method for producing a multilayer fiber product using multilayer web technology except that Begemann does not disclose the claimed filler or paper grammage. Silenius '063 is cited as teaching the use of a filler as used in the method of the present application. The Office's position is that it would have been obvious for a person of ordinary skill in the art to use the filler of Silenius '063 in the method of Begemann to obtain a surface layer having good optical properties.

Reconsideration of this rejection is respectfully requested.

The method of the present invention is characterized in that a filler used in the surface layers of a three-layer product having a grammage of 80 g/m² at the most, i.e., a thin base paper, is comprised of cellulosic or lignocellulosic fibrils on which light-

scattering material products are deposited. In the prior art for producing a multilayer web, calcium carbonate is precipitated on at least one fiber layer in connection with the web making. However, the calcium carbonate is precipitated on the fibrous material and not on fibrils as in the filler used in the method of the present invention. (See U.S. Patent Application Publication No. 2001/0045265 identified on page 4, lines 8-11, of the present application).

The use of the particular filler in the present invention comprised of cellulosic or lignocellulosic fibrils on which light-scattering material products are deposited has been found to improve formation and structural stiffness of the surface layers.

The method of the invention gives rise to two considerable advantages. First, the products are more dense and have an improved resistance to air permeability. Therefore, they are available for uses where barrier properties are of importance. Second, surface smoothness is improved. This improvement is surprisingly big and clearly better than could have been expected by the art-skilled person. If the paper is coated, the coverage of the coat is better than when conventional, mineral fillers are used, which reduces the consumption of coating materials. Also, problems relating to insufficient gloss and unevenness of printing

(mottling) are reduced. Moreover, as compared to the cited prior art, the present invention provides a much greater opacity.

The improved properties of the product obtained by the method of the present invention could not have been fairly predicted and are evidence of unexpected results, i.e., secondary considerations, that must be considered by the Office and that rebut the Office's case of *prima facie* obviousness.

Removal of the 35 U.S.C. 103(a) rejections of the claims is believed to be in order and is respectfully requested.

Double Patenting

Claims 1 and 4 are provisionally rejected for obviousness-type double patenting over claim 12 of application Serial No. 10/475,773.

Applicants request that the rejection be held in abeyance pending the determination of allowable subject matter in the present application.

The foregoing is believed to be a complete and proper response to the Office Action dated February 25, 2008, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

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In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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